



REMARKS

Status of Claims

Claims 121-122, 124, 127, 129, 131-132, 137, 143-144, 147, 153, 157-158, 161, 166, 169-170, 172, 177-180, 183, 218-219, 221, and 223 are currently pending in this application.

II. Information Disclosure Statements

Applicants thank the Office for acknowledging the references on the IDS Forms PTO/SB/08 ("SB/08 forms") submitted August 4 and 29, 2006, that have been considered. See November 23, 2006, Office Action ("Office Action") at p. 2 and initialed SB/08 forms attached thereto. However, Applicants note that the Office has not considered all the listed references. *See id.* Applicants respectfully submit that all the references were properly submitted and should have been considered.

In particular, in the Office Action, the Office states that the crossed out foreign references have not been considered, but the Office has considered the abstracts of those foreign references. *See id.* In this regard, Applicants note that translations of foreign documents are not required, and "[s]ubmission of an English language abstract of a reference may fulfill the requirement for a concise explanation." M.P.E.P.

§ 609.04(a).III. In the SB/08 forms filed with the Supplemental Information Disclosure Statements ("IDSs") on August 4 and 29, 2005, English language abstracts of the foreign documents were listed, considered, and initialed by the Office. *See Office Action* at p. 2 and initialed SB/08s, attached thereto. As such, Applicants believe they have complied with the Office's requirements for listing foreign documents; if the Office

does not agree, Applicants respectfully request citation to a rule or regulation establishing otherwise.

The Office also states that documents related to *L'Oreal S.A. v. Estee Lauder Co.*, Civ.No. 04-1660 (HAA) (D.N.J. filed Apr. 7, 2004), have not been considered as they are not prior art. See Office Action at p. 2. As Applicants explained in the Notification of Pending Litigation filed on July 23, 2004, M.P.E.P. § 2001.06(c) places the burden on Applicants to bring to the attention of the Office the existence of pending litigation. Additionally, Applicants note that material information "is not limited to prior art but embraces any information that a reasonable examiner would be substantially likely to consider important in deciding whether to allow an application to issue as a patent." M.P.E.P. § 2001.04 (emphasis in original). Accordingly, although Applicants are not representing that the litigation documents are material to the present application, out of an abundance of caution, Applicants listed the litigation documents. Therefore, Applicants request that the Office consider the litigation documents and indicate that they were considered by making appropriate notations.

Additionally, Applicants note that the Office crossed through the office actions in the copending applications listed on the returned SB/08s. In light of the Office's past representation, Applicants assume that the Office considered the references but struck them out so they would not be listed on the face of the issued patent.

Applicants have filed an IDS concurrently with this Reply. Applicants respectfully request that the Office consider each reference cited in this IDS and kindly provide an initialed copy of the SB/08 indicating that consideration. In light of the Office's past representation, if the Office strikes-through the references on the provided form,

Applicants will assume that the Office considered the references but struck them out so they would not be listed on the face of the issued patent. If the Office believes that any references are improperly cited, however, and strikes-through the reference on the provided form for that reason, Applicants request that the Office specifically so indicate and provide a citation to a regulation showing that the citation or submission was improper.

III. Rejections Under 35 U.S.C. § 103(a)

The Office has rejected claims 121-122, 124, 127, 129, 131-132, 137, 143-144, 147, 153, 157-158, 161, 166, 169¹-170, 172, 177-180, 183, 218-219, 221, and 223 under 35 U.S.C. § 103(a) as being obvious over the combination of U.S. Patent Nos. 5,783,657 ("Pavlin"), 3,148,125 ("Strianse"), and 6,214,329 ("Brieva"). Applicants respectfully traverse this rejection for the reasons already of record and those set forth below.

In making a rejection under 35 U.S.C. § 103, the Office has the initial burden to establish a *prima facie* case of obviousness. See M.P.E.P. § 2143. To meet this burden, the Office must point to some objective teaching in the prior art, coupled with the knowledge generally available to one of ordinary skill in the art at the time of the invention, that would have motivated one of ordinary skill to combine reference teachings with a reasonable expectation of success. See M.P.E.P. §§ 2143.01 and

¹ Although the Office does not indicate at page 3 of the Office Action that claim 169 is rejected, it is listed as rejected on page 2 of the Office Action Summary. Therefore, Applicants assume it was inadvertently omitted from the rejection set forth at page 3 of the Office Action.

2143.02; *In re Fine*, 5 U.S.P.Q.2d 1596, 1598, 837 F.2d 1071, 1074 (Fed. Cir. 1988).

Applicants submit that the Office has not met these criteria with respect to the proposed combination of Pavlin, Strianse and Brieva, and therefore, has not established a *prima facie* case of obviousness.

The Office asserts that Pavlin discloses the claimed structuring polymer, see Office Action at p. 3, but has admitted that it does not teach at least one pasty fatty substance, wherein said at least one pasty fatty substance comprises at least one liquid fraction and at least one solid fraction at room temperature, see May 5, 2004, Office Action at p. 4. The Office also asserts that Strianse teaches a polyamide resin (although the Office admits it is not the claimed polymer), a liquid fatty phase, and a pasty fatty substance. See Office Action at p. 5. Finally, the Office relies on Brieva for a teaching of waxes, coloring agents, amphiphilic compounds, and volatile and non-volatile oils in combination with gelling agents. See *id.* at p. 6. The Office continues to assert that the motivation to combine the ingredients from these various sources “flows logically from the art for having been used in the same cosmetic art,” and one would expect the resultant product to have the structured and transparent properties disclosed therein. *Id.* at p. 4. Applicants disagree.

A. Combination of Pavlin and Strianse

The Office has failed to demonstrate some suggestion or motivation, either in the references themselves or in the knowledge generally available to those of ordinary skill in the art, to modify Pavlin and arrive at the present invention. The Office has not provided sufficient motivation for one of ordinary skill in the art to choose any particular compound in Strianse and add it to the compositions of Pavlin. Rather, the Office

asserts that motivation for the combination lies in that both Pavlin and Strianse teach compositions containing polyamide resins that form “crystal clear products.” Office Action at p. 5. The fact that both compositions are transparent, however, would not alone be reason to combine them and is not sufficient to satisfy the burden of establishing *prima facie* obviousness. If both compositions already possess the desired properties, as the Office asserts, there would be no incentive to combine them, *i.e.*, nothing to be gained.

Furthermore, while merely identifying each of the claimed elements in the prior art would not be sufficient to establish a *prima facie* case of obviousness, in this case, all of the components of the present claims are not even present in the prior art as the Office alleges. Specifically, Strianse does not disclose a pasty fatty substance as the Office asserts.

While Strianse does disclose fatty acid esters and lanolin alcohols in a laundry list of optional ingredients and some fatty acid esters may be pasty fatty substances,² those disclosed in Strianse are not pasty fatty substances as defined by the instant claims. As the Office points out, Strianse is directed to transparent compositions. It describes “a novel lipstick which needs no opaque pigments, but only soluble or solubilized byes, and which may be free from all opaque materials. . . ,” col. 1, lns. 28-31, and to maintain this transparency, it notes that waxes should be avoided, see col. 3,

² As Applicants previously pointed out, the Office has recognized that not all fatty acid esters are pasty fatty substances and explicitly noted that while Pavlin teaches fatty acid esters, it does not teach the “at least one pasty fatty substance, wherein said at least one pasty fatty substance comprises at least one liquid fraction and at least one solid fraction at room temperature” of Applicants’ claims. See Summary of January 14, 2003 Interview.

Ins. 43-44. Furthermore, the fatty acid esters disclosed in Strianse are described as “polyamide solvents,” col. 2, ln. 66 to col. 2, ln. 4. Therefore, the substances disclosed in Strianse are liquid and do not have the solid fraction required for a pasty fatty substance defined in the present claims. Pasty fatty substances, as defined in the present invention, would contain crystalline portions, which would ruin the transparency of the compositions of Strianse.

Thus, the compounds disclosed in Strianse are not pasty fatty substances as in the present invention, and nothing else in either reference would lead one to select such compounds. If anything, the disclosure of Strianse, *i.e.*, its disclosure that the composition be free of opaque materials and waxes, teaches away from the use of pasty fatty substances as in the claimed composition. Accordingly, Pavlin and Strianse could not have provided any motivation for one of ordinary skill in the art to reach the presently claimed invention, and the rejection is improper for this reason alone.

B. Brieva does not remedy the deficiencies of Pavlin and Strianse

The fact that there is no motivation to combine Pavlin and Strianse is not remedied by the addition of Brieva. The overbreadth of the Office’s alleged motivation to combine Pavlin, Strianse, and Brieva ignores chemical compatibility and formulating realities, and is evident upon examining the teachings of the references themselves. In particular, as Applicants previously explained, Brieva actually teaches away from incorporating a polymeric gelling agent, such as the polyamides disclosed in Pavlin and Strianse, into the composition. See August 29, 2005, Amendment and Reply Under 37 C.F.R. § 1.111 at pp. 30-31. Brieva emphasizes throughout the disclosure that the composition includes a “non-polymeric gelling agent,” see *e.g.*, col. 1, ln. 64 to col. 2,

In. 3, which clearly teaches away from combination with the polyamides of Pavlin and Strianse.

The Office asserts that Brieva is relied upon for its “combination of waxes. coloring agents, amphiphilic compounds, volatile and nonvolatile oils and using this combination with compounds, which function as gelling agents.” Office Action at p. 6. The Office further asserts that it is “immaterial whether the gelling agent is polymeric or non-polymeric. . . .” *Id.* The Office’s disregard for the explicit teachings of Brieva is improper and destroys the intended purpose of the reference. Brieva explicitly only teaches exclusively the non-polymeric variety of gelling agents, not a mere preference. The Office has not provided any basis for the assertion that it is obvious to include known polymeric gelling agents in the composition of Brieva, and it is improper for the Office to disregard its explicit teachings.

Applicants therefore respectfully submit that one of ordinary skill in the art would not have been motivated to combine the polyamide polymers of Pavlin and Strianse with Brieva, a reference that goes to great length to emphasize that the gelling agent incorporated therein is non-polymeric. In sum, that which teaches away cannot, by definition, provide the necessary motivation to combine that is required to establish a rejection under 35 U.S.C. § 103: “It is improper to combine references where the references teach away from their combination.” M.P.E.P. § 2145 X.D.2. Nothing in the record provides any reason why one would have been motivated to modify a reference that uses only non-polymeric gelling agents with a polymeric gelling agent.

Furthermore, the Office has not even addressed, and thus has pointed to no reason, why one of skill in the art would have been motivated to extract the elements

disclosed in Brieva and use them in the compositions of Pavlin and Strianse. Therefore, the rejection is improper and Applicants respectfully request that it be withdrawn.

IV. Commonly Assigned Co-Pending Applications and Patents

In the submissions previously filed in this case, Applicants noted information regarding copending applications, including the present application, and submitted copies of the pending claims as of the dates of those filings for every case identified. In the following Table 1, Applicants have noted additional applications that have been filed, and enclose herewith in Exhibit 1 copies of the copending claims for those cases. Furthermore, Applicants submit herewith, also in Exhibit 1, copies of the currently pending claims from the following copending applications, which claims have been amended or issued since August 29, 2005: 09/618,066; 09/733,898; 10/046,568; 10/047,987; 10/129,377; 10/182,830; 10/198,931; 10/203,018; 10/203,254; 10/203,374; 10/203,375; 10/431,217; and 10/459,636. Applicants submit these claims for the Office's convenience in evaluating any potential issues regarding statutory or obviousness-type double patenting.

Table 1.

Attorney Docket No.	U.S. Patent Application No.	U.S. Filing Date/ 371 (c) Date	Inventors	Title	Assignment Recorded (Reel, Frame, Date)	Publication, Date
05725.0816-03000	11/212,811	August 29, 2005	Véronique FERRARI, Richard KOLODZIEJ, Carlos O. PINZON, and Paul	COMPOSITION COMPRISING A POLYAMIDE POLYMER AND AT LEAST ONE INERT FILLER	Reel 014055, Frame 0428, on March 24, 2003	U.S. Published Application No. US 2005/0287102 A1, on December 29, 2005

Attorney Docket No.	U.S. Patent Application No.	U.S. Filing Date/ 371 (c) Date	Inventors	Title	Assignment Recorded (Reel, Frame, Date)	Publication, Date
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05725.0932-01000	10/933,431	November 22, 2004	Véronique FERRARI	A TRANSFER-FREE COMPOSITION STRUCTURED IN RIGID FORM BY A POLYMER	Reel 012476, Frame 0507, on January 17, 2002	U.S. Published Application No. US 2005/0089542 A1, on April 28, 2005
05725.1003-01000	10/933,430	November 22, 2004	Nathalie COLLIN	COSMETIC COMPOSITION COMPRISING A POLYMER BLEND	Reel 013142, Frame 0645, on August 1, 2002	U.S. Published Application No. US 2005/0089505 A1, on April 28, 2005
05725.1004-01000	10/990,475	November 18, 2004	Nathalie COLLIN	USE OF A POLYMER FOR OBTAINING AN EXPRESS MAKE-UP OF KERATIN MATERIALS	Reel 012847, Frame 0285, on April 30, 2002	U.S. Published Application No. US 2005/0089491 A1, on April 28, 2005
05725.1020-01000	11/351,309	February 10, 2006	Véronique FERRARI	COSMETIC COMPOSITION CONTAINING A POLYMER AND A FLUORO OIL	Not yet recorded	Not yet published
05725.1378-00000	11/019,382	December 23, 2004	Wei YU and Véronique FERRARI	COSMETIC COMPOSITION COMPRISING TWO DIFFERENT HETERO-POLYMERS AND METHOD OF USING SAME	Not yet recorded	U.S. Published Application No. US 2005/0191327 A1, on September 1, 2005
05725.1538-00000	11/312,338	December 21, 2005	Isabelle JACQUIER	COMPOSITION AND PROCESS FOR COATING KERATIN FIBERS	Not yet recorded.	Not yet published.

Attorney Docket No.	U.S. Patent Application No.	U.S. Filing Date/ 371 (c) Date	Inventors	Title	Assignment Recorded (Reel, Frame, Date)	Publication, Date
06028. 0130- 00000	11/406,371	April 19, 2006	Véronique FERRARI and Helene KHACHIKI AN	COSMETIC COMPOSITION COMPRISING SILICA PARTICLES AND AT LEAST ONE SPECIFIC POLYMER, PREPARATIVE PROCESS AND USES	Not yet recorded.	Not yet published.

V. Conclusion

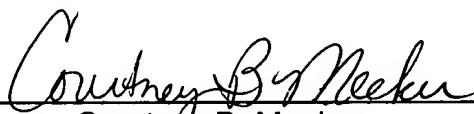
In view of the foregoing remarks, Applicants respectfully request the reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: October 20, 2006

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